

Application Serial No.: 10/772,493
Applicants: Tina L. Bramlett et al.
Response Filed: September 19, 2005
Response to Office Action Date: May 19, 2005

IV. REMARKS

United States Serial No. 10/772,493 was filed on February 5, 2004. The PTO mailed a Restriction Requirement on October 5, 2004. Applicants responded to the Restriction Requirement on October 29, 2004 by electing claims 1-19 for prosecution in the present application. However, claims 1-19 were withdrawn from consideration and claims 20-37 were examined in the Office Action mailed November 29, 2004. Thus, the PTO had inadvertently searched and examined the non-elected claims (i.e. Group II, claims 20-37), instead of the elected claims (i.e. - Group I, claims 1-19).

Applicants responded to the November 24, 2004 Office Action by requesting that the Office Action be withdrawn, that claims 1-19 be examined, and that the period for reply be reset. In the present Office Action, claims 20-37 have been withdrawn from consideration and claims 1-19 have been examined. Claims 1 and 12 have been amended by the present response. In view of the amendments and arguments set forth herein, Applicants respectfully request reconsideration and allowance of claims 1-19.

Objection to the Abstract

The text of the Abstract has been objected to under MPEP §608.01(b). Applicants have amended the Abstract by deleting the word “comprising” and inserting therefor the word “having.” Applicants respectfully submit that this amendment overcomes the objection to the Abstract.

35 U.S.C. 112 Rejection

Claims 7 and 13-17 have been rejected under 35 U.S.C. 112, second paragraph. It is alleged that these claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. It is specifically alleged that these claims include improper Markush groups.

Applicants respectfully traverse the rejection of claim 7. Claim 7 depends from claim 6. Claim 6, in turn, depends from claim 1. Claim 1 recites a bond compatible composite membrane comprising a self-adhesive material layer and a rough fabric layer adjacent to the self-adhesive layer. Claim 7, which represents one illustrative embodiment of the composite membrane, recites that the self-adhesive layer is a self-adhesive bituminous layer and that the rough fabric layer is polyester fabric layer, wherein the self-adhesive material layer comprises about 90 to about 99 weight percent of the bond compatible composite membrane and the polyester fabric layer comprises from about 1 to about 10 percent of the bond compatible composite layer. Applicants respectfully submit that claim 7 does not include alternative limitations which would require the use of Markush group phraseology. Therefore, Applicants respectfully request that the rejection of claim 7 be withdrawn.

Applicants also respectfully traverse the rejection of claims 13-17. Claims 13-17 recite limitations relating to the tensile strengths of illustrative bonding materials, which may be utilized in conjunction with the bond compatible composite membrane. Page 6, lines 19-28 and Page 7, Table I of the Specification disclose illustrative bonding materials for use in conjunction with the bond compatible composite membrane having tensile strengths of at least 3.7 psi at 0°F, at least 7.5 psi at room temperature, and at least 7.0 at 120°F. Each of claims 13-17 recite limitations relating to the tensile strengths of these illustrative bonding materials at 0°F, room temperature, and 120°F. The bonding materials are defined by the tensile strengths at these three different temperatures. Thus, the tensile

strength limitations of each of claims 13-17 are not alternative limitations which would require the use of Markush group phraseology. Therefore, Applicants respectfully request that the rejection of claim 13-17 be withdrawn.

35 U.S.C. 102(b)

Claims 1-6, 11, 12, and 18 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,564,520 ("the '520 patent"). It is specifically alleged that the '520 patent discloses an exterior finishing system comprising a substrate, a bond compatible composite membrane, an adhesive material, and a fabric layer. Applicants respectfully traverse the rejection of claims 1-6, 11, 12, and 18.

The '520 patent

The '520 patent is not directed to an exterior finishing system. To the contrary, the '520 patent is directed to a masonry block drainage system for water-sealing masonry blocks having vertical cavities. See Abstract. The masonry block drainage system collects seepage water and drains it from the interior cavities of the masonry block. See Column 1, lines 8-11. The masonry block drainage system includes a waterproofing strip for sealing water from the masonry block, a drainage fabric, and a weep member for draining water from the drainage fabric. See Column 2, lines 36-41.

Masonry blocks include at least one cavity extending vertically from the lower surface to the upper surface of the masonry block. The '520 patent expressly discloses that the waterproofing strip has a sufficient width to prevent water from entering the vertically extending cavities of the masonry block. See Column 2, lines 44-46. The masonry block drainage system is attached to the top of the masonry block, thereby preventing water from entering the vertical cavities of the blocks. See Column 3, lines 55-57. Thus, the waterproofing strip is intended to be positioned in a horizontal manner between the upper

surface of a lower course of masonry block and the lower surface of another course of masonry block. Positioning the waterproofing strip in a vertical manner on the front surface of the masonry block would not prevent seepage water from entering into the vertical cavities of the masonry block. Therefore, positioning the waterproofing strip in a vertical manner on the front surface of the masonry block would be illogical to one having ordinary skill in the construction art and would render the waterproofing strip unsuitable for its intended purpose.

A drainage fabric is used in conjunction with the waterproofing strip. The fabric member permits seepage of water to be drained by weep members. See Column 2, lines 51-54. The '520 patent expressly teaches that the use of the fabric member in conjunction with a waterproofing strip to form a masonry block drainage system is a benefit, because lateral migration of seepage water from one masonry block cavity to another can be achieved without drilling holes in the masonry blocks themselves. See Column 3, lines 8-15. The purpose of the drainage fabric is to allow water to escape from the internal vertical cavities of the masonry blocks while resisting pluggage by dirt, debris, or mortar. See Column 4, lines 27-31. The '520 patent specifically discloses that the drainage fabric is preferably a soil filter fabric or geotextile. See Column 4, lines 33-35. The drainage fabric is not intended to be a bonding surface for bonding materials or exterior finishing materials. In fact, if bonding materials or exterior finishing materials were applied to the drainage fabric, thereby covering or otherwise plugging the passages of the drainage fabric, then seepage water would be prevented from flowing from the masonry block to the weep holes.

The Present Application

Claim 1 of the present application recites “An exterior finishing system comprising a substrate; a bond-compatible composite membrane adhered to the exteriorly facing surface of said substrate, said membrane comprising a first self-adhesive material layer and a second rough fabric layer adjacent said first self-adhesive material layer, wherein said first self-adhesive material layer is adhered to said substrate, and wherein said second rough fabric layer provides a bonding surface for forming a bond with a bonding material; an exterior finishing material; and a bond formed with a bonding material, said bonding material disposed between said second rough fabric layer of said bond-compatible composite membrane and said exterior finishing material.”

The ‘520 patent does not disclose an exterior finishing system, exterior finishing materials bonded to a bond compatible composite membrane, or a bond formed between a bond compatible composite membrane and exterior finishing materials. As each and every limitation of the claim 1 of the present application is not disclosed in the ‘520 patent, claim 1 of the present application is not anticipated by the ‘520 patent. Claims 2-6, 11, 12, and 18 depend from independent claim 1 and therefore are also not anticipated by the ‘520 patent.

35 U.S.C 101 Double Patenting Rejection

Claims 1, 2, 12, and 13 have been rejected under 35 U.S.C. 101 as claiming the same invention as claims 1-4 of U.S. Patent No. 6,395,401. Applicants respectfully traverse this rejection. In order for a double patenting rejection under 35 U.S.C. 101 to be appropriate, the subject matter of the claims must be identical. The test for double patenting under 35 U.S.C. 101 is set out in *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) (“ A good test, and probably the only objective test, for same invention, is

whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention”).

Claim 1

Claims 1-4 of U.S. Patent No. 6,395,401 recite that the bond compatible composite membrane comprises a self-adhesive bituminous material layer and a polyester layer adjacent to the self-adhesive bituminous layer. Claim 1 of the present application recites that the bond compatible composite membrane comprises a self-adhesive layer and a rough fabric layer adjacent to the self-adhesive layer. Claim 1 of the present application does not recite that the self-adhesive layer is a self-adhesive bituminous layer or that the rough fabric layer is a polyester layer. Applicants, therefore, respectfully submit that claim 1 does not claim the same subject matter as claims 1-4 of U.S. Patent No. 6,395,401.

Claim 2

Claim 2 of the present application recites a bond compatible composite membrane comprising a self-adhesive bituminous material layer and a rough fabric layer adjacent to the self-adhesive bituminous material layer. Claims 1-4 of U.S. Patent No. 6,395,401 recite that the bond compatible composite membrane comprises a self-adhesive bituminous material layer and a polyester layer. Claim 2 of the present application does not recite that the rough fabric layer is a polyester layer. Applicants, therefore, respectfully submit that claim 2 does not claim the same subject matter as claims 1-4 of U.S. Patent No. 6,395,401.

Claims 12 and 13

Claims 1-4 of U.S. Patent No. 6,395,401 recite that the bond compatible composite membrane comprises a self-adhesive bituminous material layer and a polyester layer adjacent to the self-adhesive bituminous layer. Claim 12 depends from claim 1 and claim

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13 depends from claim 12. Claim 1 of the present application recites a bond compatible composite membrane comprising a self-adhesive layer and a rough fabric layer. Claim 12 is directed to illustrative bonding materials and claim 13 is directed to the tensile strengths of the illustrative bonding materials. Claims 12 and 13, however, do not recite a self-adhesive bituminous material layer and a polyester layer adjacent to the self-adhesive bituminous layer. Applicants, therefore, respectfully submit that claims 12 and 13 do not claim the same subject matter as claims 1-4 of U.S. Patent No. 6,395,401.

In view of the above remarks, Applicants respectfully request withdrawal of the statutory type double patenting rejection of claims 1, 2, 12, and 13.

Obviousness Type Double Patenting Rejection

Claims 1-19 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-13, and 15-21 of U.S. Patent No. 6,759,135. Without expressing any agreement with or acquiescence to the obviousness-type double patenting rejection and merely to advance the application to allowance, Applicants hereby file a terminal disclaimer under 37 C.F.R. §1.321(c). Applicants respectfully submit that the filing of the enclosed Terminal Disclaimer renders the obviousness-type double patenting rejection moot.

35 U.S.C. 103 Rejection

Claims 7-10, 13-17 and 19 have been rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,564,520 ("the '520 patent") in view of U.S. Patent No. 4,855,349 ("the '349 patent"). Applicants respectfully traverse the rejection of claims 7-10, 13-17 and 19.

The '520 Patent

The masonry block drainage system includes a waterproofing strip for sealing water from the masonry block, a drainage fabric, and a weep member for draining water from the drainage fabric. See Column 2, lines 36-41. The masonry block drainage system permits water-sealing of masonry blocks having vertical cavities. See Abstract. The masonry block drainage system collects seepage water and drains it from the interior cavities of the masonry block. Column 1, lines 8-11. The masonry block drainage system is attached to the top of the masonry block, thereby preventing water from entering the vertical cavities of the blocks. See Column 3, lines 55-57. Thus, the waterproofing strip is positioned in a horizontal manner between the upper surface of a lower masonry block and the lower surface of another level of masonry block. Positioning the waterproofing strip in a vertical manner on the front surface of the masonry block would be illogical to one having ordinary skill in the construction art and would render the waterproofing strip unsuitable for its intended purpose, as this would not prevent water from entering into the masonry block through the vertical cavities.

The '349 Patent

The '349 patent discloses coating mastics and caulking compositions. These coating mastics and caulking compositions are used to seal and protect architectural material substrates.

It is specifically alleged that the '520 patent discloses an exterior finishing system comprising a substrate, a bond-compatible composite, an adhesive, and a fabric layer, but that the '520 patent does not disclose the tensile strengths of the product. It is also alleged that the '349 patent discloses to manipulate the dimensions and weight amounts of a finishing system to impart desired tensile strengths. Thus, it is alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the

teaching of the secondary reference with the primary reference and facilitate/manipulate the tensile strengths of the primary reference. Applicants respectfully traverse the rejection of claims 7-10, 13-17 and 19.

Claims 7 and 8

Claims 7 and 8 of the present application relate to the composition of the bond-compatible composite membrane. The '520 patent does not disclose an exterior finish system having a substrate, a bond compatible composite membrane attached to the substrate, or exterior finishing materials applied to the bond compatible substrate. The '520 reference merely discloses a water sealing strip that is strategically positioned in a horizontal manner between two courses of masonry blocks. The '349 patent does not cure this deficiency, as it merely relates to mastic and caulk compositions for sealing architectural substrate materials. Applicants, therefore, respectfully submit that the rejection of claims 7 and 8 under 35 U.S.C. 103 should be withdrawn.

Claims 9 and 10

Claims 9 and 10 of the present application relate to the thickness of the bond compatible composite membrane. While the '520 patent discloses a thickness for water-sealing strip/drainage fabric of the masonry block drainage system, the reference simply does not disclose an exterior finish system having a substrate, a bond compatible composite membrane attached to the substrate, or exterior finishing materials applied to the bond compatible substrate. Furthermore, the water proofing strip is to be positioned in a horizontal manner between two courses of masonry block, not in a vertical manner on an exteriorly facing surface of a building wall substrate. Again, the '349 patent does not cure this deficiency, as there is no teaching in the '349 patent of composite membrane or an exterior finishing system incorporating a composite membrane. Applicants, therefore,

respectfully submit that the rejection of claims 9 and 10 under 35 U.S.C. 103 should be withdrawn.

Claims 13-17

Claims 13-17 of the present application relate to the tensile strength of the bonding materials used in the exterior finishing system. The Office Action alleges that the references are combinable “for they relate to exterior finishing systems.” Applicants disagree. The ‘520 patent is not an exterior finishing system; rather, it is directed to a masonry block drainage system. Likewise, the ‘349 patent does not disclose an exterior finishing system; rather, it is directed to mastic and coating compositions which may be used in combination with architectural substrates.

The Office Actions alleges that at column 6, lines 7-30 and column 13, lines 55-60 of the ‘349 patent it is disclosed to manipulate the dimensions and weight amounts of a finishing system to impart desired tensile strengths. Applicants respectfully submit that this allegation is not relevant to the patentability of claims 13-17. Column 6, lines 7-30 merely discloses to use a binder to increase the physical strength of the mastic or caulk, however, it does not disclose the actual tensile strength of the mastic or caulk compositions, nor does it teach or suggest an exterior finishing system. Similarly, column 13, lines 55-60 of the ‘349 patent merely discloses to add fillers and extenders to strengthen the mastic or caulk composition. Again, this passage of the ‘349 patent does not disclose the actual tensile strengths of the mastic or caulking composition, nor does it teach or suggest an exterior finish system.

As the ‘520 patent discloses a masonry drainage system comprising a water-sealing strip and a drainage fabric, there would be no logical reason to apply a mastic or caulk to the surface of the drainage fabric, as this would prevent the flow of water through the drainage fabric and from the masonry block to the weep holes. Therefore, it would not be

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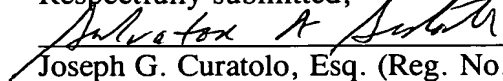
obvious to one having ordinary skill in the art to manipulate the tensile strength of the sheet material of the masonry block drainage system in the manner disclosed in the '349 patent. Applicants, therefore, respectfully submit that the rejection of claims 13-17 under 35 U.S.C. 103 should be withdrawn.

Claim 19

Claim 19 recites that the exterior finishing material is an exterior insulation and finish system. An exterior insulation and finish system generally includes an insulation layer, a base coat applied to the insulation layer, a reinforcing layer embedded in the base coat, and a finish coat applied over the base coat and reinforcing layers. The '520 patent is directed to a water sealing strip for masonry blocks and the '349 patent is directed to a mastic or caulk composition, but neither of the '520 or '349 patents disclose, suggest, or teach an exterior insulation and finish system. Applicants respectfully submit that the rejection of claim 19 under 35 U.S.C. 103 should be withdrawn.

In view of the above remarks, Applicants respectfully request that the rejections 35 U.S.C §§101, 102, 103, and 112 be withdrawn and that the Examiner issue a formal notice of allowability directed to claims 1-19. Should the Examiner have any questions, Applicants' undersigned attorney would welcome a telephone call.

Respectfully submitted,



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